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In re Application of
HAGHIRI, Yahya et al.
Application No.: 09/926,010
PCT No.: PCT/EP00/01272
Int. Filing Date: 16 February 2000
Priority Date: 17 February 1999
Attorney's Docket No.: HAGH3001/JEK
For: PORTABLE DATA SUPPORT WITH A
DETACHABLE MINI CHIP CARD

DECISION ON

REQUEST

UNDER 37 C.F.R. 1.42

This is a decision on applicants' "New Submission Under 37 C.F.R. §1.42 and Request For Reconsideration" filed on 21 October 2002.

BACKGROUND

On 16 February 2000, applicants filed international application PCT/EP00/01272. On 24 August 2000, a Demand was filed with the International Preliminary Examining Authority within nineteen months of the priority date, in which the United States was elected. Accordingly, the deadline for entry into the national stage in the United States was midnight on 17 August 2001.

On 14 August 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 06 September 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the fee for filing the oath or declaration later than thirty months were required.

On 06 March 2002, applicants filed a response to Notification of Missing Requirements accompanied by, *inter alia*, a declaration executed by heirs of the deceased, a petition for a four month extension of time and the fee for the four month extension of time.

On 27 March 2002, the Office mailed Decision on Papers Under 37 CFR 1.42 refusing applicants' request for status.

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42. As "the terms 'Executor' and 'Administrator' do not have exact counterparts in all foreign countries, ... the terms must be construed to fit

the circumstances of the case." MPEP 409.01(d). Thus, "the person or persons having authority corresponding to that of executor or administrator are permitted to make application..." MPEP 409.01(d).

In this case, Szahra Haghiri, Mana Haghiri and Touba Haghiri each signed the declaration on their own behalf as heirs to Yahya Haghiri and Touba Haghiri signed the declaration as parent for minor Sina Haghiri, who also is an heir to Yahya Haghiri.

Counsel for applicants has stated that the four heirs are all of the heirs. Counsel states that a legal representative of the deceased's estate is not required to be appointed under German law. As the heirs are signing as the heirs of the estate, it is understood that not only is a legal representative not required to be appointed, but that none has been appointed and that the heirs are acting as the legal representatives of the estate. If this is not a correct interpretation, applicants must notify the office immediately.

Under 37 CFR 1.497(a)(3), the declaration must state the citizenship of the inventor. On the first page of the declaration, Yahya Haghiri is identified as a citizen of Germany. On page three, Yahya Haghiri is identified as a citizen of Iran. The declaration fails to comply with 37 CFR 1.497(a)-(b).

Additionally, a minor may sign the declaration provided the minor has capacity, *i.e.*, that the minor understands the document. MPEP §409. Otherwise, a legal representative must sign for the minor. See 37 CFR 1.43.

CONCLUSION

For the above reasons, the request for status under 37 C.F.R. 1.42 is **REFUSED**.

Applicant is required to submit an oath or declaration in compliance with 37 C.F.R. 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. **THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 C.F.R. 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.** Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 C.F.R. 1.42."

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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